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09/751,391	01/02/2001	Kee-hwan Lee	Q62029	7508

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EXAMINER

HAQ, NAEEM U

ART UNIT PAPER NUMBER

3625

DATE MAILED: 03/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/751,391

Applicant(s)

LEE ET AL.

Examiner

Naeem Haq

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 02 January 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-42 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-42 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Correction to Previous Office Action***

This action is a correction to the last Office Action, paper number 5, mailed February 11, 2004. That action shows that only claims 1-9 were rejected over Postrel under 35 U.S.C. 103. The corrected action now shows that claims 1-5, 8-13, 16, 17, and 28-42 have been rejected over Postrel under 35 U.S.C. 102(e), and that claims 6, 7, 14, 15, and 18-27 have been rejected over Postrel under 35 U.S.C. 103. The new Office Action does not contain a PTO-892 (Notice of Reference Cited) since the cited references have not changed.

### ***Drawings***

Figure 1 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance. The Applicants have admitted in their specification that this figure is prior art (see page 1, lines 16-31).

### ***Claim Objections***

Claim 1 is objected to because of the following informalities: Each step or item listed in the claims should be followed by a semicolon except for the last item which

should end with a period. Appropriate correction is required. In the present case, the Applicants have a receiving step and a carrying out step. These two steps should be separated by a semicolon.

Claim 4 is objected to because of the following informalities: This claim recites "a customers'..." The Examiner notes that the correct punctuation should be "a customer's..." Appropriate correction is required.

Claims 7, 9, 13, 15, 17, 21, 23, 25-27, 33-35, 37, and 38 are objected to under 37 CFR 1.75 as being a substantial duplicate of claims 6, 8, 12, 14, 16, 20, 22, 24, 32, and 36 respectively. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 4-9, 10-17, and 18-27 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. These claims are not within the technological arts and/or recite a nominal use of technology. *The claimed invention must utilize technology in a non-trivial manner (Ex parte Bowman, 61 USPQ2d, 1665,1671 (Bd. Pat. App. & Inter. 2001)).* Although Bowman is not precedential, it has been cited for its analysis.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

**Claims 1-5, 8-13, 16, 17, and 28-42 are rejected under 35 U.S.C. 102(e) as being anticipated by Postrel (US Patent 6,594,640 B1).**

Referring to claims 1-5, 8-13, 16, 17, and 28-42, Postrel teaches a points trading service, the method and apparatus comprising:

- receiving through a telecommunications network a request for trading points a customer gets from a member shop (column 6, lines 13-52);
- carrying out a transaction corresponding to the request for trading points with at least one other customer (column 1, lines 22-26; column 5, lines 61-67);
- wherein the trading points are airline mileage points (column 1, lines 22-26);
- calculating a balance of the customer's remaining trading points after the customer uses the trading points to purchase a good or service (column 7, lines 31-3);

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- collecting information regarding a customer's trading points portfolio from member shops and storing the information in a customer database (column 6, lines 30-33; Figure 4);
- changing the customer's trading points into a cash equivalent and processing the customer's trading points according to the resulting cash equivalent (column 6, lines 38-52);
- a customer and transaction database for storing information on the points trade request sent from the customer and a result of processing transactions (Figure 5, Item "54");
- a shopping mall management unit for processing cyber shopping, and providing trading points in proportion to a good purchased and a service for buying goods with the trading points (column 1, line 14 – column 3, line 55; Figure 1).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 6, 7, 14, 15, and 18-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Postrel (US Patent 6,594,640 B1).**

Referring to claims 6, 7, 14, 15, and 18-27, Postrel does not teach updating a customer database and a transaction database according to a result from the trading points transaction, and sending the result to the corresponding member shop. However, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate this step into the method and apparatus of the Postrel in order to create a record of the transaction and to notify the member shop of the transaction so that it could update its database. This would serve as a "paper trail" to document the transaction in the event that a dispute occurred at a later time.

**Claims 1, 2, and 4-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kimberly Weisul "Web Brokers lure clients with premiums" hereinafter referred to as Weisul in view of Postrel (US Patent 6,594,640 B1).**

Referring to claims 1, 2, 4-7, Weisul teaches a points trading service, the method comprising the step of:

- receiving through a telecommunications network a request for trading points a customer gets from a member shop (page 1, paragraph 4);
- carrying out a transaction corresponding to the request for trading points with at least one other customer (page 1, paragraph 4);
- wherein the trading points are airline mileage points (page 1, paragraph 4).

Weisul does not teach the step of collecting information regarding a customer's trading points portfolio from member shops and storing the information in a customer database. However, Postrel teaches a points trading method, apparatus, and computing program

that collects information regarding a customer's trading points from member shops and stores the information in a database (column 6, lines 30-33; Figure 4). Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate the teachings of Postrel into the system and apparatus of Weisul. One of ordinary skill in the art would have been motivated to do so in order to provide the user with the convenience of collecting the user's information from several different entities. Weisul and Postrel do not teach updating a customer database and a transaction database according to a result from the trading points transaction, and sending the result to the corresponding member shop. However, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate this step into the method and apparatus of the cited prior art in order to create a record of the transaction and to notify the member shop of the transaction so that it could update its database. This would serve as a "paper trail" to document the transaction in the event that a dispute occurred at a later time.

### ***Conclusion***

If a copy of a provisional application listed on the bottom portion of the accompanying Notice of References Cited (PTO-892) form is not included with this Office action and the PTO-892 has been annotated to indicate that the copy was not readily available, it is because the copy could not be readily obtained when the Office action was mailed. Should applicant desire a copy of such a provisional application, applicant should promptly request the copy from the Office of Public Records (OPR) in



accordance with 37 CFR 1.14(a)(1)(iv), paying the required fee under 37 CFR 1.19(b)(1). If a copy is ordered from OPR, the shortened statutory period for reply to this Office action will not be reset under MPEP § 710.06 unless applicant can demonstrate a substantial delay by the Office in fulfilling the order for the copy of the provisional application. Where the applicant has been notified on the PTO-892 that a copy of the provisional application is not readily available, the provision of MPEP § 707.05(a) that a copy of the cited reference will be automatically furnished without charge does not apply.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Naeem Haq whose telephone number is (703)-305-3930. The examiner can normally be reached on M-F 8:00am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeff A. Smith can be reached on (703)-308-3588. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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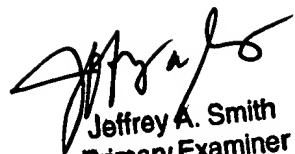
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**Naeem Haq**, Patent Examiner  
Art Unit 3625

March 9, 2004



**Jeffrey A. Smith**  
Primary Examiner